

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD RASHMAN
and DENNIS SHICK

Appeal No. 1999-0455
Application 08/635,483

ON BRIEF

Before JERRY SMITH, LEVY and BLANKENSHIP, Administrative
Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C.
§ 134 from the examiner's rejection of claims 1-3 and 5,
which constitute all the claims remaining in the application.

The disclosed invention pertains to an improved

Appeal No. 1999-0455
Application 08/635,483

stethoscope.

Representative claim 1 is reproduced as follows:

1. A stethoscope including an ear piece for detecting sounds, comprising:

a chest piece including a body having ends, further having a bore therein, running from one end to another end, and detachable diaphragm structures and bell components, wherein the diaphragm structures and bell components include diaphragm structures and bell components of varying sizes so that the stethoscope may be used with infants, or with adults, connectable to each end of the chest piece;

a revolvable valve stem having ends, disposed partially within the chest piece, so that one end of the valve stem is within the chest piece and a single portion of the valve stem protrudes from the chest piece, the valve stem having means for transmitting sounds detected by the diaphragm structures and bell components from one end of the valve stem to the opposite end of the valve stem;

a single sound conducting tube having a range of 40 to 44 gram wall tubing connected at one end to the ear piece and at the other end to the portion of the revolvable valve stem which protrudes from said chest piece.

The examiner relies on the following references:

Tynan (Tynan '087)	2,233,087	Feb. 25, 1941
Tynan (Tynan '827)	2,513,827	July 04, 1950
Smithline	2,719,594	Oct. 04, 1955
Tynan (Tynan '989)	2,722,989	Nov. 08, 1955
Kebel	3,035,656	May 22, 1962
Nelson	4,239,089	Dec. 16, 1980

The admitted prior art (Sprague).

Appeal No. 1999-0455
Application 08/635,483

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Smithline, Kebel, Tynan '989 or Tynan '827 in view of Sprague, Nelson or Tynan '087.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-3 and 5. Accordingly, we reverse.

Appellants have indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 5]. Consistent with this indication appellants have made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 1 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art

Appeal No. 1999-0455
Application 08/635,483

as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.,

Appeal No. 1999-0455
Application 08/635,483

776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 1, the examiner applies two alternative rejections. First, the

Appeal No. 1999-0455
Application 08/635,483

examiner finds that Smithline, Kebel, Tynan '989 or Tynan '827
each

teaches a stethoscope using well known tubing which includes 42 gram wall tubing. Sprague, Nelson and Tynan '087 are each cited to teach stethoscopes having diaphragm structures and bell components of various sizes. The examiner indicates that it would have been obvious to the artisan to combine these teachings [answer, pages 4-5]. Second, the examiner notes that the preceding rejection may be deemed not to teach the 42 gram wall tubing. The examiner finds that this particular type of tubing would have been an obvious design expedient [id., pages 5-6].

Appellants argue that neither Smithline, Kebel, Tynan '989 nor Tynan '087 teaches using a 40-44 gram wall tubing. Appellants also dispute the examiner's assertion that the use of such tubing would have been obvious within the meaning of 35 U.S.C. § 103. Appellants argue that the examiner has not established a proper prima facie case of obviousness. Appellants also filed two declarations under 37 CFR § 1.132 in support of their argument that the selection of 40-44 gram wall tubing was not the result of routine experimentation [brief, pages 7-10].

The examiner responds that Smithline, Kebel, Tynan

Appeal No. 1999-0455
Application 08/635,483

'989 and Tynan '827 do not specify any weight for their respective tubings. The examiner finds that these disclosures encompass all

well known and sized sound conducting tubes including 42 gram wall tubing. Alternatively, the examiner finds that there is no evidence that 40-44 gram wall tubing was not the result of routine experimentation or that 40-44 gram wall tubing is critical to the invention. With respect to the declarations filed under 37 CFR § 1.132, the examiner finds that these declarations do not provide evidence of unexpected results [answer, pages 6-9].

We agree with the position argued by appellants. First, appellants are correct that there is no specific disclosure of 40-44 gram wall tubing in either Smithline, Kebel, Tynan '989 or Tynan '827. The most that these references disclose is that the stethoscopes disclosed therein use conventional rubber tubing. There is no indication of what is conventional rubber tubing for a stethoscope. The Thorne Declaration states that most single tube stethoscopes use industry standard "Y" shaped PVC tubing of approximately 30-32 grams of weight [paragraph 4]. This evidence is not contested by the examiner. The Wells Declaration details what appellants argue is the extensive experimentation performed to find that 40-44 gram wall tubing provided the best results.

Appeal No. 1999-0455
Application 08/635,483

The examiner's rejection is tantamount to a finding of obviousness because it was "obvious to try" 40-44 gram wall tubing. "Obvious to try" is permitted within 35 U.S.C. § 103 as long as the prior art provides a reasonable expectation of success. In re O'Farrell, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988). A reasonable expectation of success has to be based on a limited number of possibilities and an expectation that the modification would achieve the results obtained. There is no evidence on this record of whether 40-44 gram wall tubing was conventional for any application. There is also no evidence on this record of the known properties of 40-44 gram wall tubing or when its use would be desirable.

The examiner's conclusion of obviousness is based on nothing more than the examiner's bare opinion that it would have been obvious to select 40-44 gram wall tubing for use in a stethoscope. The Wells Declaration challenges the examiner's belief that the invention resulted from routine experimentation. Therefore, on this record, the examiner has failed to establish a prima facie case of the obviousness of the claimed

Appeal No. 1999-0455
Application 08/635,483

invention. The examiner must provide some evidence that would
have led the

Appeal No. 1999-0455
Application 08/635,483

artisan to select 40-44 gram wall tubing for a stethoscope as claimed. Such evidence is lacking on this record.

Because the examiner has failed to establish a prima facie case of the obviousness of the claimed invention, we do not sustain the examiner's rejection of the appealed claims. Therefore, the decision of the examiner rejecting claims 1-3 and 5 is reversed.

REVERSED

)	
JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
STUART S. LEVY))
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

Appeal No. 1999-0455
Application 08/635,483

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD, 7TH FLR.
LOS ANGELES, CA 90025

JS:caw